

BEST AVAILABLE COPYRemarks

Claims 1-6 are pending. By this Amendment, claim 1 has been amended. Entry of this Amendment is proper under 37 C.F.R. §1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicants respectfully request entry of this Amendment.

Reconsideration and allowance are respectfully requested in view of the above amendments and the following remarks

Claims 1-2 and 6 are rejected under 35 U.S.C. §103(a) over Nguyen et al. (US 5,665,620), hereafter "Nguyen," in view of Wang et al. (US 4,376,672), hereafter "Wang."

Claims 3-5 are rejected under 35 U.S.C. §103(a) over Nguyen and Wang, and further in view of Shin et al. (US 6,180,457 B1), hereafter "Shin." These rejections are defective because the cited references, taken alone or in combination, fail to teach each and every feature of the claims as required by 35 U.S.C. §103. Further, the Examiner has failed to establish a *prima facie* case of obviousness in support of the rejections under 35 U.S.C. §103.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Serial No.: 09/989,250

4

Regarding claim 1, Nguyen fails to teach or suggest, among other features, the steps of “applying a photoresist to a silicon surface of the Oxide-Nitride-Silicon layered structure as part of a patterning process.” In order to overcome this deficiency of Nguyen, the Examiner relies on the teachings of Wang. In particular, the Examiner alleges that Wang “discloses a method for etching a layer of oxides with (1)..... applying a photoresist (20) to the insulating material (15) (silicon surface) as part of a patterning process (see column 3, lines 20-29; column 7, lines 20-28).” Applicants respectfully disagree and submit that the insulating material (15) of Wang does not include a “silicon surface” as alleged by the Examiner. On the contrary, the insulating material disclosed by Wang comprises a material such as silicon dioxide or silicon nitride (see, e.g., col. 8, lines 29-32 and claim 12). Nowhere does Wang disclose that the insulating material (15) has a silicon surface as alleged by the Examiner.

The Examiner further alleges that “it would have been obvious ... to combine the teachings of Nguyen and Wang ... to apply a photoresist to a silicon layer during etching process to protect it (the silicon layer) while fabrication of a semiconductor device.” Again, Applicants respectfully disagree. As detailed above, Wang does not apply a photoresist to a silicon layer. On the contrary, in Wang, the photoresist (20) is applied to an insulating layer (15) comprising, for example, silicon oxide or silicon nitride. As such, since Wang does not apply a photoresist to a silicon layer, it would not be obvious to combine Nguyen and Wang in the manner suggested by the Examiner.


Accordingly, Applicants respectfully submit that claims 1-6 are in condition for allowance for at least the reasons set forth above.

Serial No.: 09/989,250

5

In light of the above, Applicants submit that all claims are in condition for allowance. If the Examiner believes that anything further is necessary to place the application in condition for allowance, the Examiner is requested to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,


John A. Merecki
Reg. No. 35,812

Dated: 11/02/04

Hoffman, Warnick & D'Alessandro LLC
Three E-Comm Square
Albany, NY 12207
(518) 449-0044 - Telephone
(518) 449-0047 - Facsimile

Serial No.: 09/989,250

6

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☒ **FADED TEXT OR DRAWING**
- ☒ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.